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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/790,944

03/02/2004

Mary Ellen Zurko

IBM-008

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EXAMINER

LASHLEY, LAUREL L

ART UNIT

PAPER NUMBER

2132

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/790,944	Applicant(s) ZURKO ET AL.	
	Examiner LAUREL LASHLEY	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 -22 are pending and have been examined.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 08/04/04 was filed before the mailing date of the any final Office action. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

3. Claims 7 and 10 are objected to because of the following informality:

Claim 7 is recites "documents" then later recites "the document". The Examiner has interpreted this variation to be one and same.

Claim 10 recitation of the acronym "XML" should be spelled out in first usage.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5 -10, 14, 18 and 22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 5 recites the limitations "the identified elements" and "the data file". There is insufficient antecedent basis for these limitations in the claim.

Claims 6, 14, 18 and 22 recites the limitation "the configuration file". There is insufficient antecedent basis for this limitation in the claims.

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Claim 7 recites the limitation "the modifiable configuration file". There is insufficient antecedent basis for this limitation in the claim.

Claims not specifically identified are rejected by virtue of dependency. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 7-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 7-14 recite computer readable means as software only which is not within any of the four statutory categories of inventions. (see Specification, paragraph [0041])

Claims 15-18 recite a computer program product which fails to be structurally and functionally interconnected with the software in such a manner to, in and of itself, enable any usefulness to be realized (see Specification, paragraph [0009] and claims 19-22).

Claims 19-22 recite "a computer data signal embodied in a carrier wave" which is not within any of the four statutory categories of invention.

Claims not specifically identified are rejected by virtue of dependency.

7. To expedite a complete examination of the application, the claims rejected under 35 USC 101 above are further rejected as forth below in anticipation of applicant's amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Baber et al in US Patent No. 7171691 (hereinafter Baber).

For claim 1 and similar claims 7, 11, 15 and 19, Baber discloses:

A method for protecting a computing device from potentially harmful code in a document, the method comprising: (see column 2, lines 16-21: monitor content...modify malicious content...making "safe" content available)

providing one or more definitions of potentially harmful active content in an editable text file; (see column 2, lines 28-30: one or more patterns identifying malicious content...; column 2, lines 37-47: privacy policy resolution processor...)

comparing the document with each definition of potentially harmful active content in the editable text file to identify potentially harmful active content within the document; (see column 2, lines 57-59: content in document...located as violating privacy policy...; column 5, lines 8-10 policy and document compared...;column 5, lines 29-34: matching patterns...)and

modifying the document to render harmless any identified potentially harmful active content before presenting the document to the computing device (see Abstract: content

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sanitization processor; column 2, liens 30-35 and 53-55: annotation processor...annotate portions to normalized document.

For claim 2 and similar claims 8, 12, 16 and 20, Baber discloses:

The method of claim 1, further comprising syntactically examining the document and placing the document in a valid form before comparing the document with each definition. (see column 2, liens 26-27:: transcoding engine; column 3, lines 55-59: formats; column 3, line 67-column 4, line 1: input parsed to detect virus...)

For claim 3 and similar claims 13,17 and 21, Baber discloses:

The method of claim 1, further comprising transmitting the modified document to the computing device over a network after the potentially harmful active content is rendered harmless. (see column 2, lines 16-22: sanitize malicious content...make available instead of blocking; column 4, lines 28-31: document harmless before forwarded to intended recipient...)

For claim 4 and similar claims 5 and 9 Baber discloses:

The method of claim 3, wherein each definition is listed in the text file in a same language structure and schema as the document. (see column 4, lines 26-30: by example formatted patterns used to locate virulent patterns in document)

For claim 6 and similar claims 14, 18 and 22, Baber discloses:

The method of claim 1, further comprising representing the document as a first document object model (DOM) tree and the configuration file as a second DOM tree. (see column 4, lines 25-30: parsed and formed...)

For claim 10 Baber discloses:

The system of claim 7, wherein the configuration file is an XML file. (see column 1, lines 26-39; column 4, lines 17-21)

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Greene et al in US Patent No. 7263561 disclose systems and methods for making electronic files that have been converted to a safe format available for viewing by an intended recipient. Togawa in US Patent No. 6240530 discloses a virus extermination method, information processing apparatus and computer-readable recording medium with virus extermination program recorded thereon. Kim et al. in US Patent No. 6701440 discloses a method and system for protecting a computer using a remote email scanning device. Chen et al. in US Patent No. 5832208 discloses and anti-virus agent for use with databases and mail servers.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAUREL LASHLEY whose telephone number is (571)272-0693. The examiner can normally be reached on Monday - Thursday, alt Fridays btw 7:30 am & 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, Jr. can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Laurel Lashley
Examiner
Art Unit 2132

/L. L./
26 March 2008

/Benjamin E Lanier/
Primary Examiner, Art Unit 2132